

REMARKS

Claims 1, 3-7, and 12-15 are pending in this application. In this Amendment, Applicants have amended claims 1 and 7 and canceled claims 2, 8-11, and 16-33 from further consideration in this application. Applicants are not conceding that the subject matter encompassed by claims 1, 2, 7-11, and 16-33, prior to this Amendment, are not patentable over the art cited by the Examiner. Claims 2, 8-11, and 16-33 are cancelled and claims 1 and 7 are amended in this Amendment solely to facilitate expeditious prosecution of the subject matter of the remaining claims. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claims 1, 2, 7-11, and 16-33, as presented prior to this Amendment, and any additional claims, in one or more continuing applications.

By this Amendment, claims 1 and 7 are amended to incorporate subject matter canceled from claims 2 and 8-11. No new matter has been added by any of the above amendments to the claims. Reconsideration of the claims is respectfully requested in view of the following remarks.

I. Rejection under 35 U.S.C. § 103(a), Claims 1-33

The Office Action rejects the subject matter of claims 1-33 under 35 U.S.C. § 103(a) as being unpatentable over Barra et al. (U.S. Patent Publication No. 2002/0104026 A1) in view of Patterson (U.S. Patent No. 6,751,670 B1). This rejection is moot with regard to canceled claims 2, 8-11, and 16-33 and is respectfully traversed with the remaining claims.

Amended claim 1 reads as follows:

1. A method for providing electronic mail (e-mail) services, said method comprising:
 - receiving from an original sender a request for tracing notifications, for an e-mail message;
 - in response to said request, creating at least one tag for said e-mail message, indicating that said original sender is to receive said tracing notifications;
 - receiving at a computing device of the original sender said tracing notifications from one or more non-original recipients in response to said

e-mail message being forwarded by an original recipient to at least one non-original recipient; and

providing limits for said tracing notifications, wherein said providing limits further comprises one or more limiting actions selected from a group consisting of:

limiting the time during which said tracing notifications operate,

limiting the number of retransmissions for which said tracing notifications operate,

limiting said tracing notifications' operation, based on a domain policy,

limiting the content of said tracing notifications, and discontinuing said tracing notifications, in response to a signal from said original sender. (emphasis added)

The Office Action bears the burden of establishing a *prima facie* case of obviousness based on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23 U.S.P.Q.2d 1780 (Fed. Cir. 1992). Applicants respectfully submit that Abbott and Noland, taken alone or in combination, fail to teach or suggest resetting the average queue depth to less than the first predetermined threshold immediately upon the start of the server instance in response to determining that the first predetermined threshold has been exceeded. Since the references fail to teach or suggest these features, the Office Action has failed to establish a *prima facie* case of obviousness, because the Office Action does not show where each and every claim limitation is taught or fairly suggested by the applied prior art.

Barra is directed to providing specialized e-mail services to a sender, recipient or both, over a communications network. Barra establishes an online session with a computer at an e-mail center. A sender sends an e-mail packet including an e-mail message destined to a recipient together with a request for a specified verification of e-mail service to the e-mail center. This e-mail is then transmitted from the e-mail center to the recipient and, when the recipient at least receives said e-mail, the e-mail center receives notification. In turn, the e-mail center provides at least the requested e-mail notification to the sender.

Patterson is directed to tracking electronic content of an email that includes producing a file of electronic content and executable instructions that collect notification information when the content is read. Notification information is transmitted to a creator

of the electronic content. The executable instructions deny access to the electronic content until the notification information is transmitted successfully to the creator of the electronic content.

Applicants respectfully submit that Barra and Patterson, taken alone or in combination, fail to teach or suggest providing limits for the tracing notifications, where the limits consist of one or more limiting actions selected from a group consisting of: limiting the time during which the tracing notifications operate, limiting the number of retransmissions for which the tracing notifications operate, limiting the tracing notifications' operation, based on a domain policy, limiting the content of the tracing notifications, and discontinuing the tracing notifications, in response to a signal from the original sender. The Examiner alleges that this feature is taught by Barra in paragraphs [0009], [0024], and [0038], which are reproduced as follows:

[0009] Pitney Bowes, for example, has a product "iSend." ISend tracks and verifies document delivery to a sender via e-mail return receipt. The sender receives confirmation of the exact date and time the recipient retrieves the package. ISend seamlessly interfaces with all existing e-mail applications. ISend message recipients require no special software or proprietary protocols. Anyone with e-mail and web access can use it to send and receive deliveries.

(Barra, paragraph [0009])

[0024] As stated previously, the offering provided by United Parcel Service through UPS Document Exchange provides only an electronic receipt for a fee. The service does allow the capability to audit the package trail. The sender can track and verify time of receipt, opening and printing, and length of time the recipient spent reading the package. The sender must request a return receipt.

(Barra, paragraph [0024])

[0038] Certified Mail provides proof of mailing and of delivery of mail. The sender receives a mailing receipt at the time of mailing, and a record of delivery is kept at the recipient's post office. A return receipt provides the sender with proof of delivery can also be purchased for an additional fee. Certified mail service is available only for first class mail or priority mail. Certified mail is not available for international mail. And Certified Mail does not offer insurance protection. For valuables and irreplaceable items, Express Mail or insured or registered mail must be used.

(Barra, paragraph [0038])

In paragraph [0009], Barra describes a product that tracks and verifies document delivery to a sender via e-mail return receipt. The sender receives confirmation of the exact date and time the recipient retrieves the package. In paragraph [0024], Barra describes a service to audit a package trail and that the sender can track and verify time of receipt, opening and printing, and length of time the recipient spent reading the package. In paragraph [0038], Barra describes providing proof of mailing and of delivery of mail. A sender receives a mailing receipt at the time of mailing and a record of delivery is kept at the recipient's post office. A return receipt provides the sender with proof of delivery. Nowhere in these sections, or any other section of Barra, is there a teaching or suggestion of limiting the time during which the tracing notifications operate. Barra merely describes a read receipt system that works with physical packages as well as email systems. Applicants respectfully submit that the three system described by Barra, which are Pitney Bowes, United Parcel Service, and the United States Post Office do not limit by the amount of time during which the tracing notifications operate. That is, the three systems described by Barra are single use systems and do not require a limitation of an amount of time during which the tracing notifications operate, because as each item is delivered and the return receipt received the three systems terminate for that item. In contradistinction, the present application limits the time during which tracing notifications operate such that, after some predetermined time period, an e-mail message that is forwarded by an original recipient to at least one non-original recipient will not notify the original sender of the forwarding of the email. Nowhere does Barra or Patterson, taken alone or in combination, teach such a feature.

Additionally, the Office Action alleges that the cited sections of Barra teach limiting the number of retransmissions for which the tracing notifications operate. The Office Action merely cites these sections without providing any interpretation of how the section allegedly teaches or suggests this feature. Appellants respectfully submit that nowhere in this section, or any other section of Barra or Patterson, is there a teaching or suggestion of limiting the number of times an original recipient can retransmit an email to at least one non-original recipient where the tracing notifications requested by the original sender operate. Further, the Office Action alleges that the cited sections of Barra teach limiting the operation of the tracing operation based on a domain policy. Again,

the Office Action merely cites the section without providing any interpretation of how the section allegedly teaches or suggests this feature. Applicants respectfully submit that nowhere in this section, or any other section of Barra or Patterson, is there a teaching or suggestion of limiting the number of times an original recipient can retransmit to at least one non-original recipient where the tracing notifications requested by the original sender operate. That is, the cited sections of Barra describe single use systems that deliver an item and return a receipt indicating the item was delivered.

Still further, the Office Action alleges that Barra teaches limiting the content of the tracing notifications. Again, the Office Action merely cites the section without providing any interpretation of how the section allegedly teaches or suggests this feature. Applicants respectfully submit that nowhere in this section, or any other section of Barra or Patterson, is there a teaching or suggestion limiting the content of the tracing notifications. That is, nowhere in any section of Barra or Patterson is there a teaching or suggestion of analyzing the contents of the email to determine if based on the contents an original sender will be notified using tracing notification when an e-mail message is forwarded by an original recipient to at least one non-original recipient.

Even further, the Office Action alleges that Barra teaches discontinuing the tracing notifications, in response to a signal from the original sender. Again, the Office Action merely cites the section without providing any interpretation of how the section allegedly teaches or suggests this feature. Appellants respectfully submit that the receipt systems of Barra, either alone or in combination with Patterson, does not teach or suggest discontinuing the tracing notifications where an original sender is notified when an e-mail message that is forwarded by an original recipient to at least one non-original recipient is discontinued based on a signal from the original sender.

Thus, Barra and Patterson, taken alone or in combination fail to teach or suggest one or more limiting actions selected from a group consisting of: limiting the time during which the tracing notifications operate, limiting the number of retransmissions for which the tracing notifications operate, limiting the tracing notifications' operation, based on a domain policy, limiting the content of the tracing notifications, and discontinuing the tracing notifications, in response to a signal from the original sender, as recited in independent claims 1 and 7.

Furthermore, no suggestion is present in any of the references to modify the references to include such a feature. That is, there is no teaching or suggestion in Barra and Patterson, taken alone or in combination, that a problem exists for which providing limits for the tracing notifications further comprises one or more limiting actions selected from a group consisting of: limiting the time during which the tracing notifications operate, limiting the number of retransmissions for which the tracing notifications operate, limiting the tracing notifications' operation, based on a domain policy, limiting the content of the tracing notifications, and discontinuing the tracing notifications, in response to a signal from the original sender, is a solution. To the contrary, Barra merely returns a receipt to a sender when an email is delivered and/or read by a recipient and Patterson merely restricts access of electronic content sent to a recipient until verification of the recipient is received by the sender.

Moreover, neither reference teaches or suggests the desirability of incorporating the subject matter of the other reference. That is, there is no motivation offered in either reference for the alleged combination. The Examiner alleges that the motivation would be “in order to facilitate forwarding tracing notification from nonintended recipient to the original sender.” The present invention provides for providing limits for the tracing notifications, where the limits consist of one or more limiting actions selected from a group consisting of: limiting the time during which the tracing notifications operate, limiting the number of retransmissions for which the tracing notifications operate, limiting the tracing notifications' operation, based on a domain policy, limiting the content of the tracing notifications, and discontinuing the tracing notifications, in response to a signal from the original sender. As discussed above, Barra merely returns a receipt to a sender when an email is delivered and/or read by a recipient and Patterson merely restricts access of electronic content sent to a recipient until verification of the recipient is received by the sender. Neither reference teaches or suggests providing limits for the tracing notifications, where the limits consist of one or more limiting actions selected from a group consisting of: limiting the time during which the tracing notifications operate, limiting the number of retransmissions for which the tracing notifications operate, limiting the tracing notifications' operation, based on a domain policy, limiting the content of the tracing notifications, and discontinuing the tracing

notifications, in response to a signal from the original sender. Thus, the only teaching or suggestion to even attempt the alleged combination is based on a prior knowledge of Applicants claimed invention thereby constituting impermissible hindsight reconstruction using Applicants' own disclosure as a guide.

One of ordinary skill in the art, being presented only with Barra and Patterson, and without having a prior knowledge of Applicants' claimed invention, would not have found it obvious to combine and modify Barra and Patterson to arrive at Applicants' claimed invention, as recited in independent claims 1 and 7. To the contrary, even if one were somehow motivated to combine Barra and Patterson, and it were somehow possible to combine the systems, the result would not be the invention, as recited in claims 1 and 7. The resulting system would merely notify a sender that an original recipient has opened an email, and limit access to any content in the email until the sender has received verification of the recipient. The resulting system would still fail to provide limits for the tracing notifications that further comprises one or more limiting actions selected from a group consisting of: limiting the time during which the tracing notifications operate, limiting the number of retransmissions for which the tracing notifications operate, limiting the tracing notifications' operation, based on a domain policy, limiting the content of the tracing notifications, and discontinuing the tracing notifications, in response to a signal from the original sender.

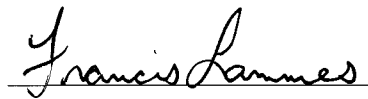
In view of the above, Appellants respectfully submit that Barra and Patterson, taken alone or in combination, fail to teach or suggest the features of claims 1 and 7. At least by virtue of their dependency on independent claims 1 and 7, the features of dependent claims 3-6 and 12-15 are not taught or suggested by Barra and Patterson, whether taken individually or in combination. Accordingly, Appellants respectfully request withdrawal of the rejection of claims 1, 3-7, and 12-15 under 35 U.S.C. § 103(a).

II. Conclusion

It is respectfully urged that the subject application is now in condition for allowance. The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

Respectfully submitted,

DATE: May 21, 2008

A handwritten signature in cursive script, reading "Francis Lammes", written over a horizontal line.

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